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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,556	02/11/2004	David B. Wood	WOOD-0006	6688

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EXAMINER

DAVIS, DAVID DONALD

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/775,556

Applicant(s)

WOOD, DAVID B.

Examiner

David D. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

2. Claim 16 is objected to because of the following informalities: In line 6 of claim 1, "has" should be deleted to preclude ambiguity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, in line 3 of claim 1 "a compact disc having a diameter less than 12 centimeters" is recited. However, the specification fails to describe how to make and/or use a compact disc having a diameter *between* 12 and zero centimeters.
4. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, "a major axis" in line 2 of claim 18 is indefinite because it is unclear as to whether "a major axis" recited in line 7 of claim 16 is referenced or an entirely different major axis.

Specifically, in lines 14-15 of claim 19 “the rectangular card-shaped container” is indefinite because it lacks antecedent basis. Also, in line 3 of claim 21 “a rectangular card-shaped” container is recited. However, it is unclear as to whether the container in lines 14-15 of claim 19 is referenced or an entirely different container.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Haddock (US 4,700,840). Haddock shows in figure 1 a combined “compact disc” 47 and container 13 for use as a business, credit or collectors card including a “compact disc” 47 having a diameter less than 12 centimeters as disclosed in column 3, lines 23-26. Figure 1 of Haddock also shows rectangular card-shaped container 13 having a minor axial dimension substantially the same as the diameter of the “compact disc” 47 for receiving and storing the “compact disc” 47.

Haddock shows in figures 1-3 that “compact disc” 47 has a non-round shape including at least two substantially parallel sides spaced apart a distance substantially the same as the minor axial dimension of the rectangular card-shaped container 13 to allow the “compact disc” 47 to be placed in the rectangular card-shaped container 13. Figures 1-3 of Haddock also show that a diameter along a major axis is sufficient to span a corresponding 8 cm depressed portion in a

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“compact disc” 47 reader tray so as to support and align the “compact disc” 47 in a “compact disc” 47 reader. See column 3, lines 23-26.

Haddock shows in figures 1-3 a substantially planar adapter 45, having an internal arcuate region having a diameter substantially the same as the “compact disc” 47 and at least two lands extending from the internal arcuate region for supporting and aligning the “compact disc” 47. The substantially planar adapter 45 has a minor axial dimension substantially the same as the minor axial dimension of the rectangular card-shaped container 13 to fit inside the rectangular card-shaped container 13 with the “compact disc” 47 contained therein. The substantially planar adapter 45 further having an arcuate outside portion having a diameter substantially the same as a corresponding 8 cm depressed portion in a “compact disc” 47 reader tray so as to align the “compact disc” 47 in a “compact disc” 47 reader. See column 3, lines 23-26.

The diameter of the arcuate outside portion of the substantially planar adapter 45 is substantially 8 centimeters. See column 3, lines 23-26. Haddock shows in figure 3 substantially planar adapter 45 has a raised portion 41 on one side thereof for engaging a corresponding slot 42 in the container 13 to secure the substantially planar adapter 45 and “compact disc” 47 into the container 13.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haddock (US 4,700,840). Haddock discloses the claimed invention (see the description *supra*), and Haddock discloses in column 3, lines 23-26 that the diameter along a major axis of the “compact disc” 47 is substantially 8 centimeters and the distance between the sides is 4.7 centimeters.

However, Haddock is silent as to parallel sides being spaced approximately 5.5 to 6.35 centimeters from one another.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to specify that the dimension of the sides of the data storage apparatus of Haddock where space approximately spaced 5.5 to 6.35 centimeters from one another instead of 4.7 centimeters.

The rationale is as follows: the purpose of the data storage apparatus is to store information. The apparatus need not have side spaced 5.5 to 6.35 centimeters from one another to store information. Realizing this, one of ordinary skill in the art at the time the invention was made would have been motivated to space side 5.5 to 6.35 centimeters instead of 4.7, which is well within the purview of a skilled artisan and absent an unobvious result, so as to provide a data storage apparatus able to be inserted and/or read in a predetermined reader.

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Allowable Subject Matter

9. Claims 19-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.


10. Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is (703) 308-1503. The examiner can normally be reached on Monday thru Friday between 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David D. Davis
Primary Examiner